

REMARKS

Claims 1-26 and 43-45 remain pending in the application without substantive amendment. Claims 27-42 and 46-49 are canceled without prejudice or disclaimer to expedite prosecution. The few minor changes made to the claims are purely formal in nature and do not introduce new matter, and accordingly entry of the Amendment is respectfully requested.

Based on the above Amendment and the following Remarks, Applicant requests that the examiner reconsider all outstanding objections and rejections, and withdraw them.

Rejection under 35 U.S.C. § 103

The examiner has rejected Claims 1-49 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,845,227 (Peterson).

Applicants respectfully traverse the rejection.

Independent Claims 1 and 10 are directed to methods of training a mobile station location identification system. Independent Claim 19 is directed to a method of calculating an estimated time of arrival of a mobile station at a segment endpoint. Independent Claim 43 is directed to a system for calculating an approximate location of a mobile station along a recurrent route of travel. What these independent claims have in common is a reference to a cell that is in communication with the mobile station, or, more specifically, to elements in a cellular communication system.

In contrast to the present invention, Peterson discloses an arrangement for providing a shortest-elapsed-time route and tracking information. Paragraph 3 of the Office Action asserts that Peterson discloses a method of determining travel time of a mobile user having a cellular phone over one or more route segments by detecting the elapsed time of hand-off from cell to cell in a cellular phone system. However, the portions of the Peterson patent to which the Office Action refers, do not in fact disclose all that the Office action asserts that Peterson discloses.

In fact, the only apparent mention of hand off from cell to cell in a cellular phone system is made at column 4, lines 40-43:

... Further example is the hand off from cell to cell in a cellular phone system) along the various route segments in order to transmit **instantaneous rate information** for those in segments to a central computer. ... (emphasis added)

First, it is noted that the Peterson patent only mentions hand-offs with reference to *instantaneous rate* information, and not to *location* information (as in embodiments of the present invention). Throughout his patent, Peterson mentions cellular telephones mainly with reference to their mere ability to communicate information between a mobile unit and a computer system (see, for example, column 8, lines 50-60), and not in reference to using of the hand-off of a particular cellular telephone from a one cellular base station to another to determine the *location* of the particular cellular telephone.

Instead, Peterson uses cellular telephones to communicate “best route” information to the cellular user; Peterson does not use the inherent functions involving cellular telephones (for example, hand-offs) to automatically determine the location of the cellular telephone. Thus, the Peterson patent does not disclose or suggest the particular features recited in the claims.

The paragraph bridging pages 2-3 of the Office Action asserts:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that when such method of determining travel elapsed time over one or more route segments using the teachings by Peterson is a done by a mobile cellphone, the hand-off detection from cell to cell in the cellular telephone system and calculating elapsed time after the mobile cellphone would have been done by decoding a first unique identifier for a cell in the communication with a mobile station at a first location and the first time; storing the first unique identifier and of the first time; decoding, upon handoff to a next cell, at a second location and at a second time, a second unique identifier for the next to cell; and storing the second unique identifier and of the second time, whereby such a method constitutes a training method for a mobile station location identification system.

However, this assertion from the Office Action is *conclusory*, not factual, in nature, and the Office Action does not follow the requirements of the law for asserting rejections under 35 U.S.C. § 103. Under *Graham v. John Deere*, the examiner must first point out (admit) the differences between the claimed invention and the cited art; and thereafter, the examiner must affirmatively indicate *why* one the skilled in the art would have been motivated to *modify* the cited art to arrive at the claimed invention.

In the present case, this burden has not been met. In particular, the Office Action does not specifically point out the distinctions between the claimed invention and the cited art. Moreover, and even more importantly, the Office Action does not provide any *reason* to support its *conclusion* that one skilled in the art would have been motivated to modify the Peterson arrangement so as to arrive at the claimed invention. Thus, the examiner is using Applicants'

own disclosure rather than, as required by law, the teachings of the prior art; and the rejection is thus based on improper hindsight.

Peterson's patent is very brief and vague in its reference to anything having to do with cellular communication systems. What is mentioned relates generally to its communication of information and not to cell identifiers. Accordingly, Peterson does not disclose, teach, or suggest Claim 1's decoding of a first unique identifier for a cell in communication with a mobile station at a first location and a first time, and decoding, upon handoff to a next cell, and a second location and at a second time, a second unique identifier for the next cell---especially in the context of a method of training a mobile station location identification system. Thus, Claim 1 should be allowable.

Independent Claim 10 recites the same features that are recited in Claim 1, and, accordingly, Claim 10 should be allowable for at least the reasons that Claim 1 is allowable.

Independent Claim 19 also recites the same features that are recited in Claim 1, in the context of a sub-method for retrieving a stored travel time. Accordingly, independent Claim 19 should be allowable for at least the reasons that Claim 1 is allowable.

Independent Claim 43 specifically recites the presence of first and a second cellular base stations that provide cellular coverage to a mobile station in respective areas including respective first and second locations, between which the mobile station's location may be calculated. Accordingly, and because of Peterson's lack of specific explanation of the application of his arrangement to cellular telephone systems, Claim 43 should be allowable for at least the same reasons that Claim 1 is allowable.

The dependent claims should be allowable for at least the same reasons that the independent claims from which they depend are allowable. Moreover, the dependent claims should be allowable based on their own merits.

For example, Claims 5-6 and 14-15 specifically recite that the unique identifier is a Cell Tower Identification Number or a Base Station Identifier. Concerning these claims, the Office Action merely states the *conclusion, without substantiation*, that "it would have been obvious... that the unique identifier for determining hand-offs from cell to cell in a cellular telephone system of Peterson include Cell Tower Identification Numbers and/or Base Station Identifiers." Applicants do not acquiesce in this unsubstantiated assertion. Applicants assert that a

prima facie case of obviousness has not been made out under the law of 35 U.S.C. § 103, and the examiner is again employing improper use of hindsight to use Applicants' own invention in formulating a rejection.

Accordingly, for at least the foregoing reasons, Applicants respectfully request that the examiner withdraw the art rejection, allow all pending claims, and pass the case to issue.

The Drawings

Applicants request that the examiner affirmatively indicate in the next written communication that the formal drawings are acceptable.

Change of Correspondence Address; New Associate Attorney


A "Revocation of Associate Power and Appointment of Attorney and Change of Correspondence Address" is filed herewith. The Appointment recognizes the undersigned attorney to prosecute the case. It is requested that the examiner verify that the address information has been entered into the PTO mailing system so that future communications will be mailed to the correct address.

Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

By: 

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